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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/540,095
Filing Date: December 30, 2005
Appellant(s): HALL, SIMON REGINALD

ALLEN E. WHITE
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/10/2010 appealing from the Office action mailed 6/8/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2001/0048955	FOREMAN ET AL.	12/2001
6,410,063	JEWELL ET AL.	6/2002
WO 01/97605	MARS UK LIMITED	12/2001
WO 01/97630	MARS UK LIMITED	12/2001

Romsos, Dale R. et al. "Regulation of protein intake in adult dogs", AVMA, vol. 182(1), 1983, pp. 41-43.

Wills, Josephine. "Adult Maintenance", BSAVA Manual of Companion Animal Nutrition & Feeding, Chapter 3, British Small Animal Veterinary Association, 1996, pages 44-46.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/97605 and WO 01/97630 in view of Foreman et al. (US Pub. 2001/0048955) taken with Jewell et al. (US Patent 6410063), and further in view of Romsos et al. (JAVMA, vol. 182(1), pp. 41-43, 1983) and Wills, Josephine ("Adult Maintenance", BSAVA Manual of Companion Animal Nutrition & Feeding, Chapter 3, British Small Animal Veterinary Association 1996, pages 44-46).

Appellant's claims include providing several food compositions that are "different and preferred quantities" to "companion animals" that encompass cats, dogs, horses,

fishes and birds (claim 8) over an "extended and pre-selected period of time", that provides fat, protein and carbohydrate, allowing these animals, birds and fishes to consume these foods over this pre-selected time period and determining a customized dietary regime from the consumed amounts of fat, protein and carbohydrate and based on providing the optimum macronutrient content. Claim 4 recites a "learning phase" of 3 days or more within the time period recited in claim 1. Claims 5-7 recite amounts of protein, fat and carbohydrate in the offered food compositions. It is being assumed that these amounts of macronutrients further define the "preferred quantities" and the ranges provide the "different" quantities. "Extended and pre-selected " periods of time include a "learning phase" which is not defined in the specification, but for examination purposes has been given the description at page 5, which is offering a single diet composition at any one feeding "experience". The learning phase therefore reads on offering "the enriched" single food composition for an undefined period of time that is 3 days at least, during which period the bird, fish, cat, dog or horse is "learning" to eat.

The WO '605 patent discloses feeding one food in the morning and one food in the evening, i.e. different food compositions, with different nutrient profiles or different contents of fat, protein and carbohydrates. Example 1 shows that 3 diets with different levels of macronutrients were offered in rotation for 30 days. A macronutrient preference for different times of the day by the animal was obtained. Amounts of protein varied between 10 to 70% and fat from 30-90%. Example 3 shows that the food was offered in 5 different diets. This data therefore suggests offering protein and fats in diets that are similar to the instantly claimed 5 and 6 in order to study the macronutrient

preference to formulate a dietary regime for the animal, based on consumption. Note that the extent of time in this study discloses that the period of time was "extended and pre-selected". The patent does disclose a preference of one type of macronutrient over another for different times of the day, thus suggesting that a macronutrient preference can be determined for the animal, but the patent does not show that the method is for determining an optimum macronutrient content. See the conclusions stated at the Examples.

The protocol stated in the WO '630 patent is similar to the WO '605 patent and provides a macronutrient diet that has between 20-75% fat and at least 25% protein. See page 4. Different diets were offered over a pre-selected and extended period of time, according to the Examples, in order to determine the macronutrient preference for different times of the day. The patent also teaches that these studies can be conducted to determine the physiological needs for any undefined "event", such as a time of stress, of a particular part of the year or week. See page 2. Claim 3 is disclosed at page 4, line 11.

Thus these patents teach offering different food compositions with differing macronutrient contents so that the animal can consume whatever is needed according to its physiological response or need (abstract WO '630), and by offering such diets over an extended and pre-selected period of time, determining a dietary regime for the animal based on the macronutrient preference by that animal. The patent teaches that it was determined that animals ate a higher protein macronutrient content in the morning and had a higher fat preference in the evening, and a dietary regime was determined

based on these results. See page 3, last paragraph and page 4, first paragraph. Claim 3 is disclosed at page 5, line 4.

The two patents do not show the carbohydrate content as in instant claim 7, although they show varying the carbohydrate content in conjunction with protein and fat. The patents do not teach a "learning phase" as described at page 5 of the instant specification.

With regard to amounts of macronutrients claimed herein, Foreman et al. teach offering a variety of foods to pets and teach a nutrient composition of protein 5-60%, fat 1-50% and carbohydrate or fiber of 1-60%. See paragraph [0032]. At col. 2, lines 23+, Jewell et al. teach a diet that contains 0 to about 20% carbohydrate, 25-70% protein and 20-70% fat. Both the WO patents claim a diet for a pet that contains 20-70% fat and at least 25% protein. Based on such, it would have been obvious to provide a carbohydrate content as disclosed by the above Foreman and Jewell patents that show these to be beneficial (Jewell, abstract, col. 2, lines 32-46).

As for the "learning phase", Rosmos et al. disclose that animals such as rats and dogs are able to self-select the diet and are able to regulate their protein and energy intake by self-selection when allowed free-choice feeding. The dogs under this study were able to choose between 2 diets that differed in protein content, and regulate their protein intake and establish a pattern within a week of the 4-week study. While Rosmos indicates a week to regulate their diet and appellant claims "3 days or more" of a learning period, this difference can be considered to be of no patentable distinction since dogs, cats, fishes and birds have different learning abilities.

Also, if the food containing the carbohydrate, fat and protein contents as shown by the primary references were to be offered in a free-choice feeding method so that the dogs are able to self-regulate not just the protein content but also the fat and carbohydrate content, then it can be reasonably expected that they would have developed a pattern with these macronutrients too, not just protein and regulated their macronutrient content with respect to carbohydrate and fat also, thus exhibiting a "learning phase" for such macronutrients too. Based on this to determine a macronutrient preference and to formulate a dietary regime would have required no more than ordinary skill.

The reference of Wills teaches that cats often detect nutritional deficiencies in their diets and have the ability to reject such diets, thus showing that animals opt for diets that are complete in the nutrients they need. The reference also states that dogs are able to become accustomed to meal times and places where they eat. Therefore, although the reference does not call this a "learning phase", it does establish that cats and dogs are a quick study or animals of habit, and learn fast enough about meals and places and this fact taken with the disclosure of Romsos which describes that the dogs established a pattern within a week with regard to regulating their protein intake, one of ordinary skill in the art would have reasonably expected such a pattern to be established in feeding the diets of the primary references as well, thus meeting claim 4. To incorporate a "learning phase" therefore, would not have required more than ordinary skill in the art at the time the invention was made.

(10) Response to Argument

At page 5 of the Brief, appellant has pointed out that the Examiner's statement that neither of the WO patents teaches the learning phase, as claimed, is "mistaken". Appellant states that WO '605 teaches such a 'learning phase' as defined in the current specification. At page 6, appellant places the disclosure of the WO '605 patent from Example 1 therein, to show that the instant specification also has the same disclosure at ¶ [0016] and ¶ [0132], under the title "Learning/training phase (39d)". Therefore, since the two disclosures pointed out have the same language and the specification has titled this as the "Learning phase", then appellant concludes that the disclosure of the WO '605 patent at Example 1 must also be the 'Learning phase' although the patent itself does not say so. Nonetheless, a closer examination of the instant claims shows that claim 1 is drawn to a "method for determining the optimum macronutrient content of a diet" for the companion animal Claim 4 which depends from claim 1 is a learning phase for such a method. Since the disclosure of the WO patent is not drawn to a method for determining the optimum macronutrient content of a diet but to a method to find the macronutrient preference of the companion animal for different times of the day (see page 2, lines 4-6 and page 8, lines 15-27), it is being held that even if Example 1 has the same experimental design of the instant specification at ¶ [0116] and ¶ [0132], the experiment at Example 1 is drawn to determine the macronutrient preference of the companion animal for different times of the day and is not a learning phase for the method for determining the optimum macronutrient content of a diet for a companion animal.

At page 9 of the Brief, appellant states that none of the WO patent used teaches the "stipulation" that the "animal can select and consume different and preferred quantities of each said food compositions" because the WO patent ('605) discloses diets with different levels of macronutrients protein and fat in 3 different ratios 10%:90%, 40%:60%, and 70%:30% (page 8, lines 10-13) and this has been deemed by appellant as the "learning phase". However, although Example 1 of the instant specification, shows a similar experimental design to Example 1 of the WO '605 patent and the instant specification calls it the "learning phase', the reference still discloses that the animal is offered different levels of macronutrients and in 3 different ratios, thus meeting the claimed limitation, "select and consume different and preferred quantities of food compositions". Furthermore, the instant specification at page 5 indicates that the learning phase is "preferably provided with single diet composition at any one feeding experience" (page 5, ¶[0021]), each single diet composition "enriched with one macronutrient at three feeding experiences".

Rosmos et al. disclose 2 diets that differed in protein content, and wherein the fat to carbohydrate ratio was also varied (see "Materials and methods", Rosmos et al.), thus also meeting this claimed limitation. Note that the study was conducted for 4-weeks with one week used to "regulate" their diet, meeting the claimed limitation of "3 days or more" (instant claim 4). At page 10 of the Brief, appellant has queried "Where is the articulated reasoning that explains how one of ordinary skill in the art would arrive at the claimed invention starting from WO 01/97605 and WO 01/97630?"

This can only be answered by considering the combination of references used to make the rejection and not just the WO patents in isolation. Clearly, the prior art disclosures of Rosmos et al and Wills establish that at the time the invention was made, it was already known that animals were able to self-select and self-regulate their diets with respect to macronutrients when exposed to a period in which varying diets were offered to them and animals opted for diets that were complete in the nutrients they needed. With regard to appellant's criticism of the use of impermissible hindsight, appellant has failed to consider part of the combination of references that were used to reject the claimed invention and therefore, it may appear to appellant that impermissible hindsight was used, although it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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